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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,585	06/27/2005	Kazuo Mizubuchi	033622-012	5370
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EXAMINER NUTTER, NATHAN M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/26/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/540,585

Applicant(s)

MIZUBUCHI ET AL.

Examiner

Nathan M. Nutter

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 March 2009 has been entered.

Specification

The disclosure is objected to because of the following informalities:

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oku (US 5,276,080).

Note column 5 (line 45) to column 6 (line 20), column 7 (lines 55-63), column 9 (lines 55-64) and the paragraph bridging column 10 (line 58) to column 11 (line 17).

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shimasaki et al (US 5,498,654).

Note the Abstract, column 3 (lines 23-35) and column 4 (lines 40-49).

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto et al (US 5,988,891).

Note the Abstract, column 4 (lines 33-52), column 5 (lines 29-44), column 5 (line 45) to column 7 (line 27).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al (US 6,675,770).

Note column 3 (lines 29-41), column 5 (lines 1-15 and 44-54), the paragraph bridging column 5 to column 6, the paragraph bridging column 11 to column 12, column 13 (lines 35-43) and column 14 (lines 29-44 and 50-56) and the Examples.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,183,594).

The reference to Yoshinaka et al teaches the production of a resin composition that may comprise a tetrafluoroethylene polymer at column 12 (lines 38-53) with zinc oxide whiskers having a tetrapodal shape with particulate and fibrous filler materials including talc, glass fiber, copper, zinc oxide, graphite, etc.. Note column 13 (lines 35-43) and column 14 (lines 29-44). Note the paragraph bridging column 11 to column 12, column 14 (lines 50-56) and the Examples for the compositional limitations that overlap with those recited herein. Note the paragraph bridging column 8 to column 9. The reference shows the contemplated sizes for the zinc oxide whiskers, as recited herein, at the paragraph bridging column 11 to column 12, and teaches the benefits of size. This suggestion is sufficient to establish a size range for the particulate and other fibrous materials as added herein. As such, the instant claim is deemed to be at least obvious, if not anticipated, by the teachings of the reference to Yoshinaka et al.

Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,310,598).

The reference teaches the production of the PTFE composition. Note column 2 (lines 4-10), the paragraph bridging column 2 to column 3, the paragraph bridging column 3 to column 4, column 6 (line 35) to column 7 (line 2) and the many Examples. Though the reference does not teach the compositional limitations of the constituents, as now claimed, a skilled artisan would know what parameters would be suitable with a view to the end-use of the composition.

Response to Arguments

Applicant's arguments filed 2 March 2009 have been fully considered but they are not persuasive.

All arguments of record are maintained herein.

The recitation of the process step "prepared by suspension polymerization" is given no patentable weight since it is not deemed to be a claim limitation. See SmithKline Beecham Corp. v. Apotex Corp., No. 04-1522 (Fed. Cir. February 24, 2006). Further, applicants contend, "the cited prior does not disclose or suggest the presently claimed invention. The cited documents do not disclose a fluororesin molding composition or sliding part molded therefrom with the composition having the specifically defined components, including the tetrafluoroethylene polymer prepared by suspension polymerization that provides a product result, in the recited amounts. In addition, the cited documents do not recognize that by following the teachings of the present invention, one can obtain the noted significant advantages set forth in Table 1 of the specification." The Examiner is at a loss to rebut the blanket argument

since nothing specific has been pointed out by applicants. With regard to the "significant advantages," applicants have not shown the same advantages to be lacking in the product compositions of the cited references. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note *In re Fitzgerald et al* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). Note MPEP § 2112-2112.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

22 March 2009